

REMARKS

Claims 1-361 are pending in the present application. The Examiner rejected all of the claims under multiplicity. MPEP 2173.05(n). According to the Examiner, the number of claims believed sufficient to properly define Applicants' invention is 50. The Examiner has further requested that Applicants select claims 1-50 for examination on the merits. Applicants respectfully traverse the multiplicity rejection and request reconsideration and reexamination of the claims.

The present invention is a complicated and important invention directed to the reproduction of music on portable terminal apparatuses, such as portable telephones. Portable telephones currently have a limited capability in reproducing music. They cannot reproduce music that sounds two or more tones nor do they provide various settings such as timbre. Applicants' invention discloses, among other things, communication technology for portable telephones that surpasses the limited capabilities of current portable telephones.

As will be discussed below, the present invention has a number of aspects that necessitate the current number of claims. It is axiomatic that Applicants have the right to determine the number and scope of their claims. This was the holding in In re Wakefield, 422 F.2d 897, 900 (CCPA 1970) (Lane, J.), the most recent case to address a multiplicity rejection:

[T]here is no statutory authority for rejecting claims as being "unnecessary." For these reasons, an applicant should be allowed to determine the necessary number and scope of his claims, provided he pays the required fees and otherwise complies with the statute.

The Examiner, however, seeks to limit Applicants' right "to determine the necessary number and scope" of their claims by rejecting the claims under multiplicity. The basis of a multiplicity rejection is not statutory. Rather, 37 CFR § 1.75(b) states that "[m]ore than one claim may be presented provided they differ substantially from each other and are not unduly

multiplied.” The reasonableness of the number of claims is considered in view of the nature and scope of the applicant’s invention and the state of the art. MPEP 2173.05(n).

Although multiplicity rejections have been upheld in the past with the Court’s approval, the current view according to the MPEP is to the contrary. Section 2173.05(n) specifically notes that Wakefield and its predecessor In re Flint, 411 F.2d 1353 (CCPA 1969), have revised the Court’s earlier view of multiplicity rejections. In both of these cases, the Court reversed the Board of Appeals for affirming an Examiner’s multiplicity rejection. Multiplicity rejections -- such as the present rejection -- are thus currently viewed with disfavor.

The Court has also required a strong showing to justify multiplicity rejections. A multiplicity rejection, if made, must be based on a conclusion drawn from the applicable facts and legal principles. “Mere opinion” is insufficient. Flint, 411 F.2d at 1356. In Flint, the Court found that the Examiner’s multiplicity rejection was not “mere opinion” because the Examiner in various office actions “set forth ‘typical examples of substantial duplication or lack of material differentiation,’ discussed the relative complexity of the invention, alleged a lack of difference in scope of the claims, and referred to representative prior art.” Id., at 1356-57. In contrast, the Office Action of the present application is silent as to the reasons for the multiplicity rejection. The Examiner has not set forth any instances of duplicative claims nor has he discussed the nature and scope of the invention and the state of the art.

It is respectfully submitted that a review of the applicable facts of the present application reveals that the rejection is unwarranted. Applicants have set forth 361 claims for the present invention. Claims 1-291 are apparatus claims, claims 292-326 are method claims and claims 327-361 are medium claims. Thirty-five of the 291 apparatus claims are independent claims. The 35 method claims and the 35 medium claims correspond to the 35 independent apparatus claims.

Given the nature and scope of the present invention, 361 claims are certainly appropriate. As discussed above, the present invention is a complicated and important invention concerning

the reproduction of music on portable terminal apparatuses, such as portable telephones. Each of the 35 independent apparatus claims focus on a particular aspect of the present invention.

For example, claim 39 features a system comprising a portable terminal and a base station where the base station transmits music information and timbre setting information to the portable terminal. The portable terminal, in turn, generates musical tones according to the transmitted music information in a timbre set according to the transmitted timbre setting information.

Claim 104, on the other hand, is directed to a portable terminal apparatus for karaoke play. The apparatus has a tone generator and a display monitor. It also includes a communication section for operating and receiving various information, a memory section that stores karaoke information including music and lyric information, a sound control section and a display control section for controlling the display monitor to display the words in parallel to the progression of the music piece.

Claim 255 features a portable terminal apparatus that retrieves music information from a removable compact memory medium and processes the retrieved music information.

These three examples illustrate that the independent apparatus claims directed to the various aspects of the invention are very different. There is no substantial duplication of claims when the independent claims range from a system for transmitting information to a portable terminal from a base station to karaoke play on a portable terminal apparatus to a portable terminal apparatus retrieving music information from a removable compact memory medium. Moreover, the fact that the claims are so different precludes any confusion on the part of the Examiner or the public. See Flint, 411 F.2d 1353, 1357 ("The claims differ from one another and we have had no difficulty in understanding the scope of protection. Nor is it clear, on this record, that the examiner or board was confused by the presentation of claims in the case or that the public will be.")

The 35 independent apparatus claims, as a group, have a total of 256 dependent claims. However, the number of dependent claims is ignored when determining the existence of duplicative claims for a multiplicity rejection. If the independent claims are different in scope, then the dependent claims from each of those independent are different in scope even though they be identical in wording. This was the holding in Flint, where the Court faced this exact situation. The Court noted that “the board’s statement acknowledges a difference in scope between the base claims, thus rendering persuasive appellant’s argument pointing out that . . . logically the sets of dependent claims differentiate themselves from each other by the differences in scope of the independent claims.” Flint, 411 F.2d at 1357.

The remaining claims -- claims 292 to 361 -- are all independent claims directed to different statutory classes. Thirty-five claims are corresponding method claims and 35 claims are corresponding medium claims. Given the importance of this invention, these claims are particularly necessary to cover different commercial products. These additional independent claims also do not pose any chance of confusion through undue duplication. Because they are directed to different statutory classes, they are obviously not duplicative.

In sum, the 35 independent apparatus claims, with the corresponding method and medium claims, are appropriate given the nature and scope of the present invention and are not duplicative. They are directed to various aspects of the present invention which, as described above, are different. Moreover, Applicants have included claims directed to different statutory classes to cover the various commercial products for this important invention. Any reduction in the number of claims would improperly narrow the scope of the invention. Accordingly, Applicants respectfully submit that the multiplicity rejection should be withdrawn.

In issuing the multiplicity rejection, the Examiner also stated, without any underlying reasoning, that the number of claims believed to be sufficient to properly define Applicants’ invention is 50. It is respectfully submitted that 50 claims are not sufficient to properly define the present invention. The three examples above illustrated some of the many aspects of the

present invention. Some other aspects defined by the claims include claims directed to a sound control apparatus (see claims 1, 11, 12 and 30) and claims featuring a portable terminal apparatus that controls tempo and mood and extracts pitch information to create music information (see claims 131, 143 and 167).

The 35 independent apparatus claims directed to these various aspects almost equal the 50 claims specified by the Examiner. Indeed, Applicants are precluded from including all of their method and medium claims that correspond to the independent apparatus claims. Under MPEP 2173.05(n), the Examiner "should be reasonable in setting the number [of claims] to afford the applicant some latitude in claiming the invention." Applicants therefore respectfully request that, if the multiplicity rejection has not been withdrawn, the Examiner should at least increase the number of claims from 50 to 105 so that Applicants may include all the independent claims of the present invention.

Finally, the Examiner requested that Applicants select claims 1-50 for examination. MPEP 2173.05(n) only requires that Examiner state a number of claims for Applicants to select. It does not require the Examiner to further select the claims. Section 2173.05(n) specifically provides: "[T]he examiner should, at the time of making the rejection on the ground of multiplicity of claims, specify the number of claims which in his or her judgment is sufficient to properly define applicant's invention and require the applicant to select certain claims, not to exceed the number specified, for examination on the merits." (Emphasis added). Thus, it is respectfully submitted that Applicants -- not the Examiner -- should select the claims for prosecution.

The Examiner's selection of claims 1-50 also illustrates the arbitrariness to the rejection. Such a selection would only cover 8 of the 35 independent apparatus claims, i.e., claims 1, 11, 12, 30, 32, 35, 37 and 39. The last included claim, claim 39, has dependent claims 40-58. Thus, the Examiner's selection would also partly cutoff some of these dependent claims. If the Examiner does not withdraw the multiplicity rejection and maintains the number of claims at 50,

Applicants respectfully request that the Examiner allow Applicants to select the 50 claims.

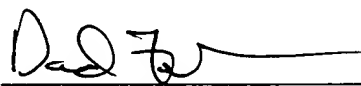
Applicants select the 35 independent apparatus claims, namely claims 1, 11, 12, 30, 32, 35, ~~37~~, 39, 59, 60, 79, 80, 85, 86, 91, 103, 104, 114, 119, 131, 143, 155, 167, 181, 193, 205, 217, 229, 241, 253, 254, 255, 267, 279 and 291. Applicant would further select the first 15 corresponding method claims, namely claims 292-306.

Applicants note that they do not object to a restriction requirement if the Examiner should feel that such requirement is proper to divide any distinct inventions recognized by the Examiner. If the Examiner feels that it would advance the prosecution of the application, it is respectfully requested that the Examiner telephone the undersigned attorney of record.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 39303.20168.00. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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